

### ***REMARKS***

This is a full and timely response to the outstanding Office action mailed April 19, 2004. Upon entry of the amendments in this response claims 1-3, 6-8, 15, 21-23, 26-28, and 30-42 are pending. More specifically, claims 1, 15 and 21 are amended; claims 4-5, 9-14, 16-20, 24-25, and 29 are canceled; and claims 30-42 are added. These amendments are specifically described hereinafter. It is believed that the foregoing amendments add no new matter to the present application.

#### **I. Present Status of Patent Application**

Claims 1-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Arnold (U.S. Patent No. 6,275,848). Claims 1-29 are further rejected under 35 U.S.C. 103(a) as being unpatentable over Beyda *et al.* (U.S. Patent No. 6,275,850) in view of Pollack (U.S. Patent No. 6,505,236).

#### **II. Examiner Interview**

Applicant first wishes to express his sincere appreciation for the time that Examiners Phan and Thompson spent with Applicant's Attorneys Jeff Kuester and Benjamin Balser during a July 28, 2004 telephone discussion regarding the above-identified Office Action. Applicant believes that certain issues were identified during the telephone discussion, and that they are resolved herein, including *Arnold* and the compression of an email as recited in claim 21 being distinguishable over compacting. During that conversation, Examiners Phan and Thompson seemed to indicate that it would be potentially beneficial for Applicant to file this amendment and response. Thus, Applicant respectfully requests that Examiner Phan carefully consider this amendment and response.

#### **III. Rejections Under 35 U.S.C. §102(e)**

##### **A. Claims 1-3, 6-8, and 15**

The Office Action rejects claims 1-3, 6-8, and 15 under U.S.C. 102(e) as being anticipated by *Arnold* (U.S. Patent No. 6,275,848). For the reasons set forth below, Applicant respectfully traverses the rejection.

**Independent claim 1** recites:

1. (Currently Amended) A method for an electronic mail server application on a host computer, comprising the steps of:  
checking an electronic mail message against a predetermined criteria; and  
***compacting a non-attachment portion of the electronic mail message*** if the predetermined criteria is satisfied.

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicant respectfully submits that independent claim 21 as amended is allowable for at least the reason that *Arnold* does not disclose, teach, or suggest at least **compacting a non-attachment portion of the electronic mail message**. Applicant respectfully submits that *Arnold* discloses detaching an attachment to a message when the message meets certain criteria. However, *Arnold* does not disclose compacting a non-attachment part of the original email. This is fundamentally different than detaching an attachment.

Notwithstanding, the undersigned has reviewed the entirety of the *Arnold* patent, and has failed to identify any such teaching anywhere within this reference. Therefore, *Arnold* does not anticipate claim 1, and the rejection should be withdrawn.

Because independent claim 1 as amended is allowable over *Arnold*, dependent claims 2-3, 6-8, and 15 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2-3, 6-8, and 15 contain all the steps/features of independent claim 1. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed.

Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claims 2-3, 6-8, and 15 are patentable over *Arnold*, the rejection to claims 2-3, 6-8, and 15 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 1, dependent claims 2-3, 6-8, and 15 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the prior art of record. Hence there are other reasons why dependent claims 2-3, 6-8, and 15 are allowable.

B. Claims 21-23, 26-28, and 30-34

The Office Action rejects claims 21-23, and 26-28 under U.S.C. 102(e) as being anticipated by *Arnold* (U.S. Patent No. 6,275,848). For the reasons set forth below, Applicant respectfully traverses the rejection.

**Independent claim 21** recites:

21. A method for managing a user's electronic mailbox on a computer, comprising the steps of:

checking the electronic mail message against a predetermined criteria; and

***compressing a non-attachment portion of the electronic mail message*** if the predetermined criteria is satisfied, wherein the step of compressing the electronic mail message is performed by searching for repeated patterns in the electronic mail message and encoding those patterns in an efficient manner.

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicant respectfully submits that independent claim 21 as amended is allowable for at least the reason that *Arnold* does not disclose, teach, or suggest at least **compressing a non-**

**attachment portion of the electronic mail message.** Applicant respectfully submits that *Arnold* discloses detaching an attachment to a message when the message meets certain criteria. However, compression of a message does not constitute detachment of any part of the original email. Compression involves, among other methods, the removal of redundancy. This is fundamentally different than detaching an attachment.

Compression works on all electronic messages, not just those with attachments. If someone wants to send a 10 megabit email message that does not have an attachment, the disclosure of *Arnold* is of no use. However, the compression limitation of the instant claim could greatly reduce the message size. Therefore, compressing the electronic mail message is not disclosed in *Arnold*.

Additional language was added to claim 21, namely, “wherein the step of compressing the electronic mail message is performed by searching for repeated patterns in the electronic mail message and encoding those patterns in an efficient manner,” only for clarification purposes. The additional language is not intended to change the scope of the claim.

Notwithstanding, the undersigned has reviewed the entirety of the *Arnold* patent, and has failed to identify any such teaching anywhere within this reference. Therefore, *Arnold* does not anticipate claim 21, and the rejection should be withdrawn.

Because independent claim 21 as amended is allowable over *Arnold*, dependent claims 21-23, 26-28, and 30-34 (which depend from independent claim 21) are allowable as a matter of law for at least the reason that dependent claims 21-23, 26-28, and 30-34 contain all the steps/features of independent claim 21. See *Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claims 21-23, 26-28, and 30-34 are patentable over *Arnold*, the rejection to claims 21-23, 26-28, and 30-34 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 21, dependent claims 21-23, 26-28, and 30-34 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct

from the prior art of record. Hence there are other reasons why dependent claims 21-23, 26-28, and 30-34 are allowable.

C. Claims 35-42

New claim 35 recites similar features as claim 21 and is considered allowable for at least the same reasons. New claims 36-42 depend from claim 35 and are considered allowable for at least this reason.

IV. Rejections Under 35 U.S.C. §103(a)

A. Claims 1-3, 6-8, and 15

The Office Action rejects claims 1-3, 6-8, and 15 under 35 U.S.C. §103(a) as being unpatentable over Beyda *et al.* (U.S. Patent No. 6,275,850 ) in view of Pollack (U.S. Patent No. 6,505,236). For the reasons set forth below, Applicant respectfully traverses the rejection.

**Independent claim 1** recites:

1. (Currently Amended) A method for an electronic mail server application on a host computer, comprising the steps of:  
checking an electronic mail message against a predetermined criteria; and  
***compacting a non-attachment portion of the electronic mail message*** if the predetermined criteria is satisfied.

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical.*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988) and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

Applicant respectfully submits that independent claim 21 as amended is allowable for at least the reason that *Beyda* and *Pollack* do not disclose, teach, or suggest at least **compacting a**

**non-attachment portion of the electronic mail message.** Applicant respectfully submits that *Beyda* and *Pollack* disclose detaching an attachment to a message when the message meets certain criteria. However, *Beyda* and *Pollack* do not disclose compacting a non-attachment part of the original email. This is fundamentally different than detaching an attachment.

Notwithstanding, the undersigned has reviewed the entirety of the *Beyda* and *Pollack* patents, and has failed to identify any such teaching anywhere within these references. Therefore, *Beyda* and *Pollack* do not anticipate claim 1, and the rejection should be withdrawn.

Because independent claim 1 as amended is allowable over *Beyda* and *Pollack*, dependent claims 2-3, 6-8, and 15 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2-3, 6-8, and 15 contain all the steps/features of independent claim 1. See *Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claims 2-3, 6-8, and 15 are patentable over *Arnold*, the rejection to claims 2-3, 6-8, and 15 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 1, dependent claims 2-3, 6-8, and 15 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the prior art of record. Hence there are other reasons why dependent claims 2-3, 6-8, and 15 are allowable.

**B. Claims 21-23, 26-28, and 30-34**

The Office Action rejects claims 21-23, and 26-28 under 35 U.S.C. §103(a) as being unpatentable over *Beyda et al.* (U.S. Patent No. 6,275,850 ) in view of *Pollack* (U.S. Patent No. 6,505,236). For the reasons set forth below, Applicant respectfully traverses the rejection.

**Independent claim 21** recites:

21. A method for managing a user's electronic mailbox on a computer, comprising the steps of:

checking the electronic mail message against a predetermined criteria; and ***compressing a non-attachment portion of the electronic mail message*** if the predetermined criteria is satisfied, wherein the step of compressing the electronic mail message is performed by searching for repeated patterns in the electronic mail message and encoding those patterns in an efficient manner.

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical.*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988) and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

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Compression works on all electronic messages, not just those with attachments. If someone wants to send a 10 megabit email message that does not have an attachment, the disclosures of *Beyda* and *Pollack* are of no use. However, the compression limitation of the instant claim could greatly reduce the message size. Therefore, compressing the electronic mail message is not disclosed in *Beyda* and *Pollack*.

Additional language was added to claim 21, namely, “wherein the step of compressing the electronic mail message is performed by searching for repeated patterns in the electronic mail message and encoding those patterns in an efficient manner,” only for clarification purposes. The additional language is not intended to change the scope of the claim.

Notwithstanding, the undersigned has reviewed the entirety of the *Beyda* and *Pollack* patents, and has failed to identify any such teaching anywhere within this reference. Therefore, *Beyda* and *Pollack* does not anticipate claim 21, and the rejection should be withdrawn.

Because independent claim 21 as amended is allowable over *Beyda* and *Pollack*, dependent claims 21-23, 26-28, and 30-34 (which depend from independent claim 21) are allowable as a matter of law for at least the reason that dependent claims 21-23, 26-28, and 30-34 contain all the steps/features of independent claim 21. See *Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claims 21-23, 26-28, and 30-34 are patentable over *Beyda* and *Pollack*, the rejection to claims 21-23, 26-28, and 30-34 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 21, dependent claims 21-23, 26-28, and 30-34 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the prior art of record. Hence there are other reasons why dependent claims 21-23, 26-28, and 30-34 are allowable.

C. Claims 35-42

New claim 35 recites similar features as claim 21 and is considered allowable for at least the same reasons. New claims 36-42 depend from claim 35 and are considered allowable for at least this reason.

V. Prior References Made of Record

The prior references made of record have been considered, but are not believed to affect the patentability of the presently pending claims. Other statements not explicitly addressed herein are not admitted.



***CONCLUSION***

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1-3, 6-8, 15, 21-23, 26-28, and 30-42 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'JKuester', is written over a horizontal line.

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